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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,378	06/01/2001	Robert R. Turvey	J-2904	2808

7590 10/08/2003
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1525 Howe Street
Racine, WI 53403-2236

EXAMINER

PARADISO, JOHN ROGER

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 10/08/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,378

Applicant(s)

TURVEY, ROBERT R.

Examiner

John R. Paradiso

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) 37-86 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendments

1. In view of the amendments filed 7/17/2003, the rejections to the claims under 35 U.S.C. § 112 are hereby withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 12, 13, 17-19, 30, 31, 35, and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by THIEMAN (US 5956924).
4. THIEMAN discloses a method of producing plastic bags in which a web (102) of plastic is folded and a closer tape (32, 34) is secured to the free upper ends of the folded web. The ends are folded together and the ends of the closer tape is secured to the folded web. End stops (36, 38) are formed and indicia formed thereon. The bags are then sealed and severed from each other. (See THIEMAN column2 line 34 to column 3 line 25 and Figures 1 and 6.)
5. Note that the claimed “indicia” are being read on the pattern formed on the endstops of THIEMAN, since indicia is broadly defined as “distinctive marks” (Merriam Webster Dictionary) and the patterned marks on the endstops of THIEMAN are distinctively patterned.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-11, 14-16, and 20-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over THIEMAN (US 5956924).

8. THIEMAN discloses a method of producing plastic bags, as described above.

9. THIEMAN does not specifically disclose the indicia being made by embossing with an ultrasonic welding horn and anvil or the endstop indicia being representative of production information.

10. Regarding claims 2-6, 14-16, 20-24, and 32-34, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use an ultrasonic welding horn and anvil to emboss the indicia in the invention of THIEMAN in order to minimize heat in the apparatus, since the examiner takes Official Notice of the equivalence of ultrasonic welding and heat-sealing for their use in the package-making art and the selection of any of these known equivalents to seal and emboss the endstops in the invention of THIEMAN would be within the level of ordinary skill in the art.

11. Regarding claims 7-11 and 25-29, THIEMAN discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to = since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

12. Further, regarding claims 7-11 and 25-29, it is well known in the art to provide production information on packaging (and in everyday life, for instance on milk cartons and bread closures to mark the time and date of production or expiration of contents) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the indicia on the endstops of the invention of THIEMAN in the form of indicia representative of production information in order to provide the consumer with more information about the container.

Response to Arguments

13. Applicant's arguments filed 7/17/2003 have been fully considered but they are not persuasive.

14. Applicant states on page 6 of his Response that "None of the cited references discloses or suggests creating indicia in an end stop. In fact, Thieman discloses a method of producing plastic bags in which fastener strips are secured to ends of a folded web of plastic. Portions of the length of the fastener strips are heat sealed to form corner seals and end stops at various locations along the fastener strips. Thiemann does not, however, disclose or suggest creating indicia in the end stops. The indicia created in the end stops, according to the present invention, can identify the production line that produces the bag and/or ... specify a date when the bag was produced."

However, the pattern on the end stops of THIEMAN do constitute indicia, as defined by Merriam-Webster, 10th edition: "1. Distinctive marks. 2. Indications." The distinctive marks of THIEMANN are being read as indicia. The rejection of the claims detailed above was made with the rationale stated in paragraph 7 above and also keeping in mind that although differences between a claimed invention and the prior art cannot be ignored merely because those differences reside in the content of printed matter, where the printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 403-404 (Fed. Cir. 1983). In other words, although the printed matter must be considered, in that situation it may not be entitled to patentable weight. Id.

Reference Citations

15. The following prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:

- HAMBACH discloses a method of closing packages in which the bag closures (22) are printed with production data.
- YACKO ET AL discloses a method of packaging in which the ends of the bag are printed with indicia to help a user.
- VOSHALL ET AL discloses a method of packaging in which the ends of the bag are printed with indicia to help a user.
- McKEE discloses a method of packaging in which the ends of the bag are printed with indicia to help a user.
- THOMPSON, JR. discloses a method of packaging in which indicia (30) is embossed on the package.

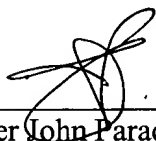
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Conclusion

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.



Examiner John Paradiso: (703) 308-2825

October 6, 2003

Additional Phone Numbers:

Supervisor Rinaldi Rada: (703) 308-2187

TC 3700 Receptionist: (703) 308-1148

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